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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,913	07/31/2006	Nobuo Takeshita	1190-0632PUS1	2547
2292 7590 02/04/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
AGUSTIN, PETER VINCENT				
ART UNIT		PAPER NUMBER		
2627				
NOTIFICATION DATE		DELIVERY MODE		
02/04/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/587,913

**Applicant(s)**

TAKESHITA ET AL.

**Examiner**

Peter Vincent Agustín

**Art Unit**

2627

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-6, 9, 10 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) 14-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 9 is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 21 and 22 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This application is a national stage entry (371) of PCT/JP04/12089, filed August 24, 2004.
2. Claims 1, 4-6, 9, 10 & 14-22 are currently pending, with claims 14-20 withdrawn from consideration due to a previous restriction requirement.

***Election/Restrictions***

3. Newly submitted claims 21 & 22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 21 & 22 recite the special technical feature “wherein non-reproducing areas of the odd numbered recording layers are mutually aligned in the thickness direction of the test recording areas of the even numbered layers and vice versa”, which special technical feature is not found in the originally elected claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21 & 22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5, 6 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US 7,274,638) in view of Shoji et al. (US 2003/0137915).

In regard to claim 1, Lee et al. disclose a recording method (see title) for an optical disc (Figure 5A) having at least three recording layers (L0-L3), the method including a step of recording and reproducing test data for determining the optimal recording power (understood from “OPC”) when user data are recorded in each recording layer, and determining the optimal recording power by evaluating the reproduction results (understood from “OPC”), wherein when test recording areas are formed by recording the test data, the test recording areas in the odd-numbered recording layers (see OPC\_L1 & OPC\_L3) and the test recording areas in the even-numbered recording layers (see OPC\_L0 & OPC\_L2) do not overlap in the thickness direction (as shown) of the optical disc, the test recording areas in the odd-numbered recording layers are mutually aligned in the thickness direction (see OPC\_L1 & OPC\_L3), and the test recording layers in the even-numbered recording layers are mutually aligned in the thickness direction (see OPC\_L0 & OPC\_L2).

However, Lee et al. do not disclose: in regard to claim 1, that the test recording areas in the odd-numbered recording layers are formed adjacent one of the innermost circumference and the outermost circumference of the optical disc, and the test recording areas in the even-

numbered recording layers are formed adjacent another one of the innermost circumference and the outermost circumference of the optical disc.

Shoji et al. disclose: in regard to claim 1, a test recording area (Figure 10, element 1002) in an odd-numbered recording layer formed adjacent an innermost circumference of an optical disc (1000), and a test recording area (1004) in an even-numbered recording layer formed adjacent an outermost circumference of the optical disc (as shown).

It would have been obvious to one of ordinary skill in the art at the time of invention to have applied this teaching of Shoji et al. to the method of Lee et al., the motivation being to reduce influence of degradation of one test recording area to another test recording area (see paragraph 0164).

In regard to claim 5, Lee et al. disclose that the test recording areas are formed in positions facing a reproduce-only area of the optical disc (as shown in Figure 5A).

Claims 6 & 10 have similar limitations as claims 1 & 5 and are rejected on the same grounds.

#### ***Allowable Subject Matter***

7. Claims 4 & 9 are allowed over the prior art of record for the reasons noted in the previous Office action.

#### ***Response to Arguments***

8. Applicant's arguments filed on December 10, 2008 have been fully considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is (571) 272-7567. The examiner can normally be reached on Monday-Thursday 8:30 AM-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter Vincent Agustin/  
Primary Examiner, Art Unit 2627